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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------|-------------------------------------------------------------------------------------------------------------------------------------------|
| Proceeding | 91218616 |
| Party | Plaintiff Brown Brothers Harriman & Co. |
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| Date | 06/01/2015 |
| Attachments | Motion to Suspend Proceeding (Opp. No. 91218616).pdf(287170 bytes) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|---------------------------|-----------------|
| In re the Application of: | Robert Berry |
| Serial No.: | 86160577 |
| Filed: | January 8, 2014 |
| For the Alleged Mark: | BBH |

Published in the Official Gazette on June 3, 2014,

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|--------------------------------|---|-------------------------|
| Brown Brothers Harriman & Co., |) | |
| |) | Opposition No. 91218616 |
| Petitioner, |) | |
| |) | |
| v. |) | |
| |) | |
| Robert Berry, |) | |
| |) | |
| Applicant. |) | |
| _____ |) | |

PETITIONER'S MOTION TO SUSPEND THE PROCEEDING PENDING THE BOARD'S RULING ON
PETITIONER'S MOTION TO COMPEL DISCOVERY

Pursuant to TBMP §510.03(a) and 37 CFR §2.120(e)(2), Petitioner Brown Brothers Harriman & Company ("Petitioner") hereby requests that the Board suspend the present proceeding until it rules on Petitioner's Motion to Compel the Deposition of Robert Berry and for the Production of Documents, dated May 5, 2015 (the "Motion to Compel"). *See Docket Entry #6.*

A. BACKGROUND

On January 8, 2014, Applicant filed U.S. Trademark Application Serial No. 86160577 for the BBH mark under Section 1(a), asserting use of the mark since June 1, 2010 for a laundry list of goods in Class 25, namely, clothing, namely, tops, bottoms, shirts, shoes, socks, underwear, sleepwear, sweat shirts, sweat pants, hooded sweat shirts, sweat jackets, sweat shorts, gloves, jackets, hats, head wear, and pants.

On October 1, 2014, Petitioner lodged the instant Opposition Proceeding against Mr. Berry's application. Therein, Petitioner pleaded priority of use and that Applicant's BBH trademark is identical and confusingly similar to Petitioner's BBH trademarks.

Petitioner served Interrogatories and Requests for Production of Documents on Applicant on December 1, 2014. Applicant responded to Petitioner's Requests for Production on January 2, 2015, with the majority of the response containing the phrase, "The documents can be made available for inspection at 4401 W Slauson Ave, Los Angeles CA, 90043 at a mutually convenient time and, if necessary, subject to an appropriate protective order." *See Docket Entry #5, Exhibit E*. Shortly thereafter, Petitioner's counsel attempted unsuccessfully to arrange a date and time for inspection of Applicant's documents and things.

Given issues raised by Applicant's responses to Petitioner's Interrogatories and Request for Production of Documents, as well as Petitioner's own investigation, Petitioner filed a Motion for Leave to File a First Amended Notice of Opposition on January 29, 2015, to assert Applicant's lack of ownership of the BBH mark and fraud perpetrated by Applicant on the USPTO. *See Docket Entry #5*.

On April 2, 2015, Petitioner sent a Notice of Deposition to Applicant via U.S. mail and email. Therein, Petitioner noticed Applicant's deposition in Los Angeles for April 23, 2015 (at the office of a law firm about nine miles from Applicant's office). Petitioner also subpoenaed Applicant to produce those documents and things Applicant claimed to possess and have available in his responses to Petitioner's discovery requests. Concurrently and repeatedly thereafter, Petitioner asked Applicant both in writing (emails) and by telephone to: (a) confirm his availability for the noticed deposition; or (b) propose alternative dates for his deposition.

On April 29, 2015, six days after the date noticed for his deposition, Applicant responded via email requesting to reschedule the deposition. Immediately thereafter, Petitioner's counsel requested Applicant's availability during the weeks of May 11 and May 25, 2015. Applicant did not respond to Petitioner's request and has not further communicated with Petitioner's counsel as of the date of this filing.

Due to of Applicant's failure to sufficiently communicate and work with Petitioner on this matter, and because discovery closes in this instant proceeding on June 8, 2015, Petitioner filed the Motion to Compel Discovery with the Board on May 5, 2015, to ensure its rights were preserved and it would have a sufficient opportunity to conduct discovery.

B. ARGUMENT

The Board expects each party to cooperate in the discovery process and to make a good faith effort to satisfy the discovery requests of its opponent. *See* 37 CFR §2.120(a)(3). Petitioner offered numerous dates for Applicant to choose from when scheduling his deposition. Additionally, Petitioner made it known that the deposition was to be conducted less than 10 miles from Applicant's place of business. Petitioner made a good faith effort to resolve Applicant's failure to cooperate, as required by Trademark Rules 2.120 (e)(1) and 2.120(h)(1), prior to seeking the Board intervention with the Motion to Compel Discovery and this motion to suspend the proceeding pending the Board's ruling on the Motion to Compel.

The Board has inherit power to stay proceedings on its own initiative, upon motion or upon stipulation of the parties approved by the Board. When a party files a motion to compel discovery, the Board is to issue an order suspending the proceeding with respect to all matters not germane to the motion. *See* 37 CFR §2.120(e)(2), TBMP 510.03, *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1430 (TTAB 1998). Moreover, the proceeding is deemed suspended as of the filing of the motion to compel

discovery. *See Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1430 (TTAB 1998). Considering the filing of the Motion to Compel, the Board is acting in unanimity with the foregoing if it grants this motion to suspend the proceeding.

Should the foregoing not be sufficient reason for the Board to suspend the instant proceeding, Petitioner moves the Board to suspend the proceeding for good cause as the deposition of Applicant and the production of documents is vital to Petitioner's case. *See* TMBP §510.03(a). Petitioner sought to and continues to seek to depose Applicant, as he is the owner of the application in question and has vital knowledge regarding this matter that Petitioner cannot secure by other means. In addition, Petitioner's requests for production of documents and things at the deposition are necessary to answer Petitioner's questions regarding: (1) Applicant's ownership in the trademark application in question; (2) Applicant's usage of the BBH mark; (3) products and services associated with Applicant's use of the BBH mark; and (4) trade channels and customers of Applicant.

Taking into account that discovery in this proceeding closes on June 8, 2015, Petitioner has little time to schedule the deposition of the Applicant and the production of documents. Exacerbating the situation is Applicant's repeated failure to respond adequately to Petitioner's discovery requests. Considering that Applicant's deposition and the production of documents requested by Petitioner are essential to Petitioner's case, suspending this proceeding until the Board rules on the Motion to Compel is reasonable and demonstrates sufficient good cause.

C. REQUEST

Petitioner requests that the Board suspend this instant proceeding as of May 5, 2015, until the Board has had time to rule on the Motion to Compel, and to reset the date of when discovery closes and associated deadlines.

Dated: June 1, 2015

Respectfully submitted,

Edge Law Group

/Allen J. Baden/

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Petitioner's Motion to Suspend the Proceeding was transmitted to the named Applicant by email with service by First Class Mail, postage prepaid, the 1st day of June 2015, addressed as follows:

Robert Berry
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thisisrobchina@gmail.com; blackbeverlyhills@gmail.com

/Christopher J. Bella/
Christopher J. Bella

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